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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,017	01/03/2006	Peter James Burn	P70883US0	2023
<div>136                      7590                      .05/01/2007 JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004</div>				
			EXAMINER YANG, ANDREW	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 05/01/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/552,017

Applicant(s)

BURN ET AL.

Examiner

Andrew Yang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/27/06</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities:

On page 9, line 7, "know" should be replaced with --known--.

Appropriate correction is required.

### ***Claim Objections***

Claims 1, 4, 5, 6, and 10 objected to because of the following informalities:

In claim 1, line 3, "surface" should be replaced with --surfaces--.

In claim 4, line 2, "feature" should be replaced with --features--.

In claim 5, line 7, ")" should be removed after "media"

In claims 6, line 3, "or" should be replaced with --of-- after "whether"

In claim 10, line 9, ")" should be removed after "annulus".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claim 6, the phrase "or some equivalent" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those

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encompassed by "or some equivalent"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Gauchet (U.S. Patent No. 6395032).

Gauchet discloses an intervertebral disc prosthesis that defines a space confinement housing. The housing has top and bottom surfaces 4 for engaging respective upper and lower adjacent vertebrae and is enclosed by a bellows 16 around the perimeter of the disc and extending between top and bottom surfaces 4 (Figure 1). Within the housing is a force transferring media that includes a liquid 20, a body 22, and a pocket of gas (column 3, lines 62-63). Since the force transferring media is largely a liquid 20, compression on one side of the disc will cause expansion in other areas of the disc. The expansion however is limited by body 22, which is internally attached to the housing (Figure 1). The bellows 16 acts as a motion-limiting feature that restricts the maximum separation of the top and bottom surfaces since the bellows 16 will have a maximum length it will extend before failure.

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Claim 3, 4 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferree (U.S. Patent No. 6419704).

Ferree discloses an intervertebral disc having a body with a final volume and superior and inferior surfaces to conform to vertebral endplates (Column 2, Lines 50-55). The body is inflatable with a gas or liquid (Column 5, Lines 40-45) to act as a force transferring media and allowing the body to expand and contract in a manner similar to a natural disc (Column 2, Lines 54-56). The body can have one or more fiber-reinforced layers on the periphery of the body to enhance the strength of the implant and contain outward expansion (Column 5, Lines 30-35). The implant is implanted by forming a flap in the annulus fibrosis, and removing the degenerated disc or residue there of, and then inserting the implant. (Column 6, Lines 15-21). Once the implant is in place, the flap of the annular fibrosis is restored to the functional position (Column 4, Lines 59-61).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 7166131, 6582466; U.S. Publication No. 2003/0045939, 2003/0023311.

Any inquiry concerning this communication from the examiner should be directed to Andrew Yang whose telephone number is 571-272-3472. The examiner can normally be reached Monday-Friday 7:30 am – 5:00 pm EST.

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If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Eduardo Robert can be reached at 571-272-4719. The fax number for the organization where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private Pair only. For More information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (USA OR CANADA) or 571-272-1000.

A.Y.

4/19/2007



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER